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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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1333 7590 11/02/2006

PATENT LEGAL STAFF
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EXAMINER

WALKE, AMANDA C

ART UNIT PAPER NUMBER

1752

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,133

Applicant(s)

MEMETEA ET AL.

Examiner

Amanda C. Walke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
4a) Of the above claim(s) 25-36,40-55 and 59-68 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24,37,38 and 56-58 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-24, 37-39, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levanon et al (WO 01/096682) in view of Aoai et al (6,013,411) or Kawauchi et al (6,423,467).

Levanon et al teaches a photoresist and an imageable element that contains the the composition. The photoresist composition contains the instantly claimed acetal polymer, and further teaches that other known resins such as phenolic resins, styrene-maleic anhydrides, and polyvinyl ketones may be added (page 13, lines 5-16). The reference fails to specify the types of phenolic resins preferred. Aoai and Kawauchi teach that conventional phenolic resins include novolacs, cresols, xylenols, bisphenol A, resorcinol, and pyrogallol. It would have been obvious to one of ordinary skill in the art to prepare the material of Levanon et al choosing to add the resins of Aoai et al or Kawauchi et al with reasonable expectation of achieving a material having a high etch resistance.

Response to Arguments

3. Applicant's arguments filed 8/18/2006 have been fully considered but they are not persuasive. Applicant has argued that he is "perplexed" by the withdrawal of claims 30, 31, 42, 43, 49, 50, 61, 62, 67, and 68, however, these claims were withdrawn from consideration by the

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response to restriction filed by application on 11/7/05, when applicant elected the group that did not contain those claims and presented no arguments to the restriction requirement. Therefore, claims 25-36, 40-55, and 59-68 were withdrawn from consideration, and an election of species was then presented to claims within the elected group of claims (1-24, 37-39, 56-58).

With respect to applicant's argument that the Levanon reference may not be combined with either the Kawauchi reference or the Aoai reference the examiner respectfully disagrees. The primary reference Levanon teaches that additional resins (binder resins) such as known phenolic resins may be added to its material. Both of the secondary references teaches that suitable phenolic binder resins include those listed above, which appear to be polyhydric phenols. The references are solely relied upon for this teaching, not the method or material of the references as a whole, just for the teachings of conventional phenolic binder resins. Therefore, it remains the position of the examiner that one of ordinary skill in the art would have been motivated to employ the conventional phenolic binder resins taught by the secondary references as the phenolic resin in the Levanon reference.

Lastly, with respect to applicant's argument that the references fail to teach the addition of the phenolic resin to the primary reference's material for the same purpose as the instant invention (as a developability-enhancing compound), the examiner also respectfully disagrees and maintains her position. The Levanon reference clearly teaches the inclusion of a phenolic resin thus providing motivation to include conventional resins such as those described by the secondary references. When this material is made, it is the position of the examiner it would also meet the limitations of the instant claims, and that regardless of the purpose of its addition, the addition of the phenolic resin to the material would cause the material to function in the same

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way. The prima facie case of obviousness is not undermined simply because applicant's motivation for teaching to add the compound to the material differs from that of the prior art's motivation. In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc), cert. Denied, 500 U.S. 904 (1991).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C. Walke whose telephone number is 571-272-1337. The examiner can normally be reached on M-R 5:30-4.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amanda C Walke
Primary Examiner
Art Unit 1752

ACW
October 30, 2006


AMANDA WALKER
PRIMARY EXAMINER

10/30/06